

REMARKS

The Applicants have studied the Office Action dated September 9, 2004 and have made amendments to the claims to distinctly claim and particularly point out the subject matter which the Applicants regard as the invention. No new matter has been added. It is submitted that the application, as amended, is in condition for allowance. The Applicants have canceled claims 2, 10 and 18 without prejudice and added new claims 25-27. By virtue of this amendment, claims 1, 3-9, 11-17, and 19-27 are pending. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

In the Office Action, the Examiner:

- (2) rejected claims 1-24 under 35 U.S.C. §103(a) as being unpatentable over Hight (U.S. Patent Publication No. 2003/0218539) (Hereinafter "Hight").

Rejection under 35 U.S.C. §103(a) as Unpatentable over Hight

As noted above, the Examiner rejected claims 1-24 under 35 U.S.C. § 103(a) as being unpatentable over Hight. The Examiner cites 35 U.S.C. §103 as the basis for the rejection. The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention "as a whole."

The subject application discloses a system, method, and computer program product for tracking at least one item. The method on a device includes determining a location of the device and determining whether the location of the device is within a predefined area. The method further includes determining whether the at least one item is within a range. If the at least one item is not within the range and if the location of the device is not within the predefined area, the location of the device is stored. If the device is operating in active mode, an alarm is sounded indicating that the at least one item is not within the range. The disclosed system, method and computer program product

further operate to couple devices to items through various techniques, such as by determining that an item is moving with the device. The disclosed system, method and computer program product further allow remote device to query for stored locations of specific items that are stored in the device, and the requested item's location data is communicated amongst the devices.

An example of the operation of the invention defined by the pending claims is a personal effects tracking system that allows one to track, for example, a wallet, keys, a purse, a backpack, a book, a laptop computer, a handheld computer, a mobile telephone and a money clip. An exemplary embodiment of the presently claimed invention utilizes a mobile telephone wireless device as a tracking device that couples with and tracks at least one personal effect items. Once items in this exemplary embodiment are within radio communications range, the item is coupled with the tracking device. Once a personal effect item is coupled to a tracking device, the tracking device continues to observe if the personal effects items are within a predetermined range of the tracking device. The tracking device further determines if it is in a predefined area. When the tracking device determines that it is no longer in the predefined area and the coupled personal item is no longer within the predetermined range, the tracking device stores its location so as to allow the user to determine the last point where the personal effect item was known to be.

Various operating modes of the exemplary embodiment further allow the user to take personal effect items to which the tracking device is not coupled and move with those personal effect items. The tracking device observes this movement of the personal effect items with the tracking device, and therefore with the user, and determines that the personal effect items are moving with the person. Personal effect items can then be "coupled" to the tracking device by observing this same movement of the tracking device and personal items for a predefined distance or predefined period of time.

The Hight reference, on the other hand, discloses a system and method for tracking a target apparatus with a master tracking apparatus. Either the target apparatus or the

master tracking apparatus is able to initiate an alarm condition and the alarm condition is sent to the other apparatus. Hight, Abstract.

Claims 2, 10 and 18

The Applicants have canceled claims 2, 10 and 18 without prejudice, thereby rendering their rejection moot. Applicants have further amended claims 2 and 11 to depend from claims 1 and 7, respectively.

Claims 1 and 13

With regards to independent claims 1 and 13, the Applicants have amended these independent claims to more clearly define the claimed invention. The amendments to independent claim 13 are discussed below. Amended independent claim 1 is a method that corresponds to the apparatus of amended independent claim 13. Independent claim 13 has been amended to specify a device for tracking at least one item, comprising:

- a location module for determining a location of a device;
- a receiver connected to the device for receiving signals from at least one item;
- location information for a predefined area;
- a processor for determining whether the location of the at least one device is within the predefined area by comparing the location to the location information for the predefined area and determining whether the at least one item is within a range of the device; and
- a storage module for storing the location of the device if in response to determining that the at least one item is not within the range and if that the location of the device is not within the predefined area.

The applicants have amended independent claim 13 by specifying that the receiver is connected to the device and that the storage module stores the location of the device in response to determining that the at least one item is not within the range and that the location of the device is not within the predefined area. Support for these amendments is found in the specification at, for example, page 7, lines 7-19 and page 18, line 7-23. No new matter has been added. These claims have been further amended by specifying that the processor determines whether the location of the device is within the

predefined area by comparing the location to the location information for the predefined area. Support for this amendment is found in the specification at, for example, page 18, lines 15-21. No new matter has been added by these amendments.

The Applicants respectfully assert that the teachings of Hight do not include "location information" or a "processor" as specified by claim 13. The teachings of Hight do not include "location information for a predefined area" that is used in "determining whether the location of the device is within a predefined area by comparing the location to a specification of the predefined area" as is claimed for the present invention. The Applicants respectfully assert that the teachings of the prior art of record do not include defining an area in a way that is accessible to processor.

The Examiner correctly states that Hight "fails to disclose storing the location if the at least one item is not within the range and if the location of the device is not within a predefined area." Office Action dated Sept. 9, 2004, page 3. Because the teachings of Hight do not include a processor that makes the determinations of the processor defined by amended independent claim 13, the teachings of Hight do not include a "storage module for storing the location of the device in response to determining that the at least one item is not within the range and that the location of the device is not within the predefined area" as is set forth for amended independent claim 13.

The Applicants further assert that the modification of the teachings of Hight to achieve the presently claimed invention yield an inoperable combination. The teachings of Hight do not include determining if the tracking device is within a predefined area and, in response to such a determination, storing any information. The teachings of Hight are restricted to present time tracking and identifying and do not include storing location information in any way. If references taken in combination would produce a "seemingly inoperative device," the courts have held that such references teach away from the combination and thus cannot serve as predicates for a *prima facie* case of obviousness. *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969) (references teach away from combination if combination produces seemingly inoperative device);

see also *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (inoperable modification teaches away).

The Applicants traverse the Examiner's assertion that it would have been obvious to one skilled in the art "to store the location of the device 104 in the system as desired because it might be needed or useful for future use." *Id.* The Applicants assert that where the prior art has no teaching or suggestion of a storage module as set forth in independent claim 13, the teaching of this element cannot come from the Applicants' own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and *In re Fitch*, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art reference Hight does not even suggest, teach or mention storing any location information, let alone storing location information in response to the determinations recited for amended independent claim 13.

The Applicants further assert that Official Notice would be an improper basis for the Examiner's assertion regarding the obviousness of the claimed "storage module." Official notice is proper for "facts outside of the record which are capable of instant and unquestionable demonstration as being 'well-known' in the art."¹ If the Examiner is basing the assertion of obviousness of the "storage module" on official notice, the Applicants respectfully request that a reference be cited.²

If, however, the Examiner's statements are based on facts within the personal knowledge of the Examiner, the Applicants respectfully request that the Examiner support these references by filing an affidavit as is allowed under MPEP §707, citing 37

¹ See, MPEP §2144.03, citations omitted.

² See, MPEP §2144.03, "If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position."

CFR 1.104(d)(2), and as specified in MPEP §2144.03.³

Claims 4, 15, 19, and 23

The Applicants have amended dependent claims 4, 15, 19 and 23 to more clearly describe the alarm recited in those claims. Support for these amendments is found in the specification at, for example, page 20, lines 10-13. No new matter was added by these amendments.

Claims 6, 16, 20, and 12

With regards to amended dependent claims 6, 16, 20 and 12, the Applicants have amended dependent claim 16 to further specify that "the processor determines whether the at least one item is within a range of the device due to the receiver receiving a signal from the at least one item." Dependent claims 6, 12 and 20 have been similarly amended. Support for these amendments is found in the specification at, for example, page 7, lines 8-19, page 9, lines 1-8 and page 19 lines 19-21. No new matter has been added.

The Applicants respectfully assert that the teachings of Hight depend upon a continuous wireless communications link between the master tracking apparatus and the target tracking apparatus. The teachings of Hight do not use receipt of a signal transmitted by the items being tracked to determine if an item is not within a range. The teachings of Hight include "out-of-range" signals that are sent from the master tracking apparatus to the target tracking apparatus. The invention as claimed by amended claim 16, in contrast, determines when an object is "out-of-range" by being outside of radio contact. The inability of the operation of the present invention to communicate with items outside of radio contact renders the system of Hight inoperable. If references taken in combination would produce a "seemingly inoperative device," we have held that such references teach away from the combination and thus cannot serve

³ See, MPEP §2144.03, "When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the

as predicates for a *prima facie* case of obviousness. *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969) (references teach away from combination if combination produces seemingly inoperative device); see also *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (inoperable modification teaches away).

The Applicants assert that the Hight reference does not teach the use of these communications standards, especially for use in "determining whether the at least one item is within a range of the device," as is claimed for these amended dependent claims. The Applicants respectfully assert, for the reasons discussed above, that the Applicants' own specification cannot be used to teach this limitation and that official notice is not a valid basis for a teaching of these limitations. The Applicants respectfully traverse taking of official notice as a teaching of these limitations and respectfully request a reference be cited for these limitations or, if the Examiner is relying upon personal knowledge, that the Examiner file an affidavit as is allowed under MPEP §707.

Claim 5

With regards to amended dependent claim 5, the Applicants have amended dependent claim 5 to more clearly describe the claimed method as including "storing, in response to determining that the current time is not within the predefined time period and that the at least one item is not within the predetermined range, the location of the device." Support for this amendment is found in the specification at, for example, page 21, lines 5-21. No new matter has been added by this amendment.

The Examiner correctly states that Hight fails to disclose the additional elements recited for dependent claim 5. The Applicants, however, respectfully traverse the Examiner's unsupported assertion that these elements are obvious. This assertion of obviousness is without any citation to the prior art for these two limitations and includes an admission by the Examiner that the prior art does not teach these elements. The Applicants assert that where the prior art has no teaching or suggestion of "determining whether examiner."

the current time is within a predefined time period" and "storing, in response to determining that the current time is not within the predefined time period and that at least one item is not within the predetermined range, the location of the device" as set forth in amended dependent claim 5, the teaching of this element cannot come from the Applicants' own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and *In re Fitch*, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art reference Hight does not even suggest, teach or mention anything related to these limitations, and the Applicants respectfully assert that the rejection of claim 5 under 35 U.S.C. §103(a) should be withdrawn.

The Applicants further assert that Official Notice would be an improper basis for the Examiner's assertion regarding the obviousness of the limitations of dependent claim 5. Official notice is proper for "facts outside of the record which are capable of instant and unquestionable demonstration as being 'well-known' in the art."⁴ If the Examiner is basing this assertion of obviousness on official notice, the Applicants respectfully request that a reference be cited.⁵

If, however, the Examiner's statements are based on facts within the personal knowledge of the Examiner, the Applicants respectfully request that the Examiner support these references by filing an affidavit as is allowed under MPEP §707, citing 37 CFR 1.104(d)(2), and as specified in MPEP §2144.03.⁶

Claim 7

⁴ See, MPEP §2144.03, citations omitted.

⁵ See, MPEP §2144.03, "If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position."

⁶ See, MPEP §2144.03, "When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the

With regards to claim 7, the Applicants have amended independent claim 7 to more clearly describe that "detecting that at least one item has come within a range of the device" and "determining that the at least one item is moving within the range of the device while the device is moving." Support for these amendments is found in the specification at, for example, page 22, lines 9-22. No new matter has been added.

The Applicants respectfully assert that the prior art of record does not teach "detecting that at least one item has come within a range of the device" or "determining that the at least one item is moving within the range of the device while the device is moving" as is claimed for amended independent claim 7. In considering this claim "as a whole," it is to be noted that the claim is addressed to a method comprising:

determining a location of the device;
detecting that at least one item has come within a range of the device;
determining that the device is moving; and
determining that the at least one item is moving within the range of the device while the device is moving.

The applicants assert that this combination is not taught or suggested by the prior art of record.

The Examiner correctly states that Hight "fails to state the determining of the at least one item coming within a range." Office Action, page 4. The Applicants respectfully traverse, however, the Examiner's assertion that "it would have been obvious to one skilled in the art, determining the item being within a range is an equivalent function, which is what is done in Hight." *Id.* The Applicants assert that "detecting that at least one item has come into a range of the device" is distinct from detecting that at least one item is already within a range of the device, as is taught by Hight.

With further regards to amended independent claim 7, the Applicants note that the Examiner provides no page number citation to support the Examiner's assertion that

examiner."

Hight teaches "determining that the device is moving." The Applicants respectfully assert that the Hight reference does not teach or suggest these limitations of the claimed method. In considering this claim "as a whole," the "device" which is moving is distinct from the at least one item being tracked. The Applicants find no teaching in the Hight reference of determining motion of their "master tracking apparatus." Applicants respectfully request a citation in the Hight reference for the asserted teaching.

Claim 8 and 9

With regards to claims 8 and 9, The Applicants have amended these claims to more clearly describe their limitations. Support for these amendments is found in the specification at, for example, page 22, lines 9-22. No new matter has been added. The Examiner correctly states that the limitations of these claims are not taught by the Hight reference. The Applicants respectfully assert that official notice is not a proper basis for a "teaching" of the limitations of these claims for reasons discussed above and respectfully request a citation to a reference teaching these limitations. The Applicants re-assert, as is also discussed above, that it is improper to rely upon the Applicants' own specification as a teaching of these limitations. If, as further discussed above, the Examiner is relying upon personal knowledge in this rejection, the Applicants respectfully request that the Examiner support these references by filing an affidavit as is allowed under MPEP §707.

Claim 17 and 21

With regards to claim 17 and 21, the Applicants have amended these claims to recite limitations similar to amended independent claim 13. Support for these amendments is similarly found in the specification at the locations cited above for claim 13. No new matter has been added. Since amended independent claims 17 and 21 recite limitations similar to those of amended independent claim 13, amended independent claims 17 and 21 distinguish over the prior art of record for at least the same reasons. The Applicants' remarks concerning amended independent claim 13 also apply to amended independent claims 17 and 21, particularly with respect to the alleged obviousness of claim elements not contained in the cited prior art.

Claim 24

With regards to claim 24, the Applicants have amended dependent claim 24 to more clearly describe the "the processor ... further retrieves location information from the storage module in at least one of the at least one device, so as to find the last stored location of the at least one item." Support for this amendment is found in the specification at, for example, page 24, line 13 through page 25, line 4. No new matter has been added. The Applicants respectfully traverse the Examiners statement of the obviousness of the limitation of claim 24. Applicants re-assert that a proper rejection cannot use the Applicants' disclosure as the only teaching of the claim limitation. If the Examiner is basing this assertion of obviousness on official notice, the Applicants respectfully request that a reference be cited. If, as further discussed above, the Examiner is relying upon personal knowledge in this rejection, the Applicants respectfully request that the Examiner support these references by filing an affidavit as is allowed under MPEP §707.

Additionally, Applicants note that dependent claims 3-6 and 25-27 depend from amended independent claim 1, claims 8-9 and 11-12 depend from amended independent claim 7, and that claims 14-16, 19-20, 22-24 depend from amended independent claims 13, 17 and 21, respectively. As discussed above, amended independent claims 1, 7, 13, 17 and 21 distinguish over the cited prior art. Since dependent claims include all of the limitations of the independent claims from which they depend, Applicants further assert that dependent claims 3-6, 25-26, 8-9, 11-12, 14-16, 19-20 and 22-27 also distinguish over the cited prior art as well. Therefore, Applicants respectfully assert that the Examiner's rejection of claims 1, 3-9, 11-24 under 35 U.S.C. §103(a) over Hight should be withdrawn.

Claim 25-27

The Applicants have added new claim 25-27. The Applicants respectfully assert that the subject matter of these new claims is not taught or suggested by the prior art of record.

New claim 25 is directed to the method as set fourth in claim 4 with the further limitation of "determining if the at least one item has not been left in the predefined area" and further describing that "wherein performing the notification is performed in response to determining that the at least one item has not been left in the predefined area." Support for this claim is found in the specification at, for example, page 19, line 22 through page 20, line 13. No new matter has been added.

New claim 26 is directed to the method of claim 4 and specifies that "performing the notification is selectively performed based upon a status indicator." Support for this claim is found in the specification at, for example, page 12, lines 6-12. No new matter has been added.

New claim 27 is directed to the method of claim 1 and further specifies "retrieving the stored location of the device" and "communicating the location amongst at least one remote device." Support for this claim is found in the specification at, for example, page 24, line 14 through page 25, line 4. No new matter has been added.

CONCLUSION

The foregoing is submitted as full and complete response to the Official Action mailed August 27, 2004, and it is submitted that Claims 1, 3-9, 11-17, and 19-27 are in condition for allowance. Reconsideration of the rejection is requested. Allowance of Claims 1, 3-9, 11-17, and 19-27 is earnestly solicited.

If for any reason the Examiner finds the application other than in condition for allowance, or the Examiner believes that there are any informalities which can be corrected by Examiner's amendment, a telephone call to the undersigned at (561) 989-9811 is respectfully solicited.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the

scope of any claim, unless Applicants have argued herein that such amendment was made to distinguish over a particular reference or combination of references.

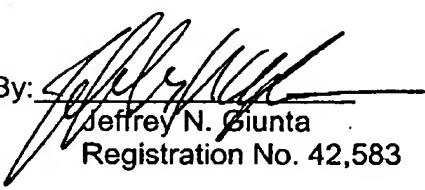
In view of the preceding discussion, it is submitted that the claims are in condition for allowance. Reconsideration, re-examination, and allowance of the claims is requested.

Respectfully submitted,

Date: December 9, 2004

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